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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,639	01/22/2007	Jochen Peters	DE030396US	9240

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS
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EXAMINER	
HOLMES, MICHAEL B	
ART UNIT	**PAPER NUMBER**
2121	
MAIL DATE	**DELIVERY MODE**
10/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/588,639	PETERS ET AL.	
	Examiner	Art Unit	
	Michael B. Holmes	2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *(3)* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 August 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *07 August 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

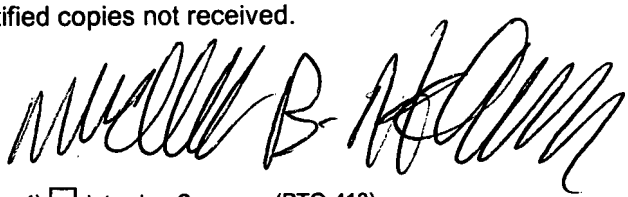
a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *08/07/2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

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Examiner's Detailed Office Action

1. This Office Action is responsive to communication, filed 08/07/2006.

2. Claims 1-20 have been examined.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. The invention as disclosed in claims 1-20 are rejected under 35 U.S.C. § 101 as being non-statutory subject matter. *see In re Comiskey,* Case No. 2006-1286, at 8, 16 & 17 (Fed. Cir., September 20, 2007). Only if the requirements of § 101 are satisfied is the inventor "allowed to pass through to" the other requirements for patentability, such as novelty under § 102 and, non-obviousness under § 103. Moreover, "...when an abstract concept has no claimed practical application, it is not patentable."

5. *No preemption is permitted* i.e., when a claim is so broad that it reads on both statutory and nonstatutory subject matter, *it must be amended.* A claim that recites a computer that solely calculates a mathematical formula is not statutory. In other words, one may not patent a pro-

cess that comprises every "substantial practical application" of an abstract idea, because such a patent in "practical effect would be a patent on the [abstract idea] itself." Regarding claims 1-20 i.e., "a method of generating a text segmentation model," would in fact cover virtually any and all forms of generating structured documents from unstructured text, per se. Moreover, nothing is specified in the claims to limit the invention to a particular application. Without clearly stating in the claim a particular application, it *preempts* all forms of prediction. Where as, the courts have also held that a claim may not preempt ideas, laws of nature or natural phenomena. The concern over preemption was expressed as early as 1852. See Le Roy v. Tatham, 55 U.S. (14 How.) 156, 175 (1852) ("A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right."); See Funk Bros. Seed Co. v. Kalo Inoculant Co., 333 U.S. 127, 132, 76 USPQ 280, 282 (1948).

6. The claims fail to provide a "useful, concrete or tangible result." Moreover, there must be a practical application, by either (1) transforming (physical thing) or (2) by having the **FINAL RESULT** (not the steps) achieve or produce a "useful" (specific, substantial, AND credible), "concrete" (substantially repeatable/non-unpredictable), AND "tangible" (real world/non-abstract) result. Moreover, the claims are directed to an abstract idea rather than a practical application of an abstract idea which would produce a "useful, concrete or tangible results." Accordingly, the claims fail to provide a practical application and is insufficient to establish a real world "tangible" result, *see In re Warmerdam*, 31 USPQ2d, 1354.

7. Claims 11-16 are considered to be directed to a computer program product comprising program code, for controlling a processor. However, the program code is devoid of a computer readable medium for storing the computer program product. Moreover, computer program pro-

duct as claimed does not produce any "useful, concrete or tangible results" that has a real-world practical application. Moreover, the claims are directed to an abstract idea rather than a practical application of an abstract idea which would produce a "useful, concrete or tangible results." In other words, merely manipulating data not tied to the real-world is not patent eligible subject matter, *see In re Warmerdam*, 31 USPQ2d, 1354. Accordingly, the claims fail to provide a practical application and is insufficient to establish a real world "tangible" result.

8. Claims 17-20 constitute system of software modules devoid of any apparent hardware, and therefore are computer programs e.g., "functional descriptive material." Moreover, since the computer programs are not embodied on an appropriate computer-readable storage medium, they are not patent eligible subject matter in accordance with *In re Warmerdam*, 31 USPQ2d, 1354. Furthermore, as mentioned above, the software modules as claimed does not produce any tangible result that has a practical application i.e., merely manipulating data not tied to the real-world is not patent eligible subject matter, *see In re Warmerdam*, 31 USPQ2d, 1354.

9. Devoid of such, applicant's claimed invention is an abstract idea e.g., a computational model or a mathematical manipulation of a function or equation. A process that merely manipulates an abstract idea or performs a purely mathematical algorithm is non-statutory despite the fact that it might inherently have some usefulness. *see In re Sarkar*, 588 F.2d at 1335, 200 USPQ at 139, wherein the court explained why this approach must be followed:

> No mathematical equation can be used, as a practical matter, without establishing and substituting values for the variables expressed therein. Substitution of values dictated by the formula has thus been viewed as a form of mathematical step. If the steps of gathering and substituting values were alone sufficient, every mathematical equation, formula, or algorithm having any practical use would be per se subject to patenting as a "process" under 101. Consideration of whether the substitution of specific values is enough to convert the disembodied ideas present in the formula into an embodiment of those ideas, or into an application of the formula, is foreclosed by the current state of the law.

10. A claim is limited to a practical application when the invention as claimed, produces a concrete, tangible and useful result; i.e., the invention recites a steps or a process or act of producing something that is concrete, tangible and useful. *See AT &T*, 172 F.3d at 1358, 50 USPQ2d at 1452. *See* MPEP § 2106(IV) The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. Remember, the claims define the property rights provided by a patent, and thus require careful scrutiny. Therefore, it is not enough to set forth invention in the specification. The claims must also reflect the scope and breath of applicant's invention. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551(CCPA 1969). The situation in this application appears to be more difficult since it does not appear that the practical application is contained within the specification.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-20 is/are rejected under 35 U.S.C. 102(b) as being anticipated by Yamron et al. (USPN 6,052,657).

Regarding claims 1, 10 & 17.

Yamron et al. describes a method of generating a text segmentation model for the segmentation of a text into sections of text on the basis of training data, wherein each section of text is assigned to a topic, the method of generating the text segmentation model comprising the steps of: generating a text emission model to provide a text emission probability being indicative of a section of text being correlated to a topic, generating a topic sequence model to provide a topic sequence probability being indicative of a probability of a sequence of topics within the text, generating a topic position model to provide a topic position probability being indicative of a position of a topic within the text, generating a section length model to provide a section length probability being indicative of the length of a section of text that is assigned to a topic. [Abstract, C 1, L 12 to C 3, L 43 et seq.]

Regarding claims 2-9, 11-16 & 18-20 of which, add no novelty and therefore are rejected under the same rationale as their respective base claim. [Abstract, C 1, L 12 to C 3, L 43 et seq.]

Claim Objection(s)

13. The claims contain numerical references embedded in parenthesis e.g., (100), (102), (108) etc. etc. etc. … all of which will need to be removed from the claim language. The rationale is that references change. Appropriate correction is required.

Correspondence Information

14. Any inquires concerning this communication or earlier communications from the examiner should be directed to Michael B. Holmes, who may be reached Monday through Friday, between 8:00 a.m. and 5:00 p.m. EST. or via telephone at (571) 272-3686 or facsimile transmission (571) 273-3686 or email michael.holmesb@uspto.gov.

If you need to send an Official facsimile transmission, please send it to (571) 273-8300.

If attempts to reach the examiner are unsuccessful the Examiner's Supervisor, Anthony Knight, may be reached at (571) 272-3687.

Hand-delivered responses should be delivered to the Receptionist @ (Customer Service Window Randolph Building 401 Dulany Street Alexandria, VA 22313), located on the first floor of the south side of the Randolph Building.

Finally, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Moreover, status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) toll-free @ 1-866-217-9197.

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